

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-2, 5-90, 92-96, 99, and 104-108, are pending, Claims 74-85, 99 and 105-108, having been amended and Claims 91, 97-98, and 100-103 having been canceled without prejudice or disclaimer by way of the present amendment.

In the outstanding Office Action, Claims 1, 2, 5-73, 86-90, 92-96 and 104-108 were indicated as being allowed; Claim 99 was objected to as being dependent upon a rejected base claim but would otherwise be allowable; Claims 105-108 were rejected under 35 U.S.C. § 112, second paragraph; Claims 74-85 were rejected under 35 U.S.C. § 102(e) as anticipated by Tanaka (U.S. Patent Application Publication 2002/0108043, hereinafter “Tanaka”); Claims 97, 98 and 101 were rejected as being anticipated by Lee et al (U.S. Patent 6,792,542, hereinafter “Lee”); Claims 91 and 100 were rejected as being unpatentable over Lee in view of Kate (U.S. Patent 6,023,490); and Claims 102 and 103 were rejected as being unpatentable over Knutson et al. (U.S. Patent 6,788,710, hereinafter “Knutson”) in view of Official Notice.

As a preliminary matter, Applicants appreciatively acknowledge the courtesy of Examiner Albertalli having a discussion regarding Claim 74 with the undersigned on April 14, 2010. During the discussion, the undersigned indicated that Claim 74 would be amended to indicate that the claim was directed to a “non-transitory” recording medium, and also that the first audio signal would be compressed and encrypted when combined. It was also discussed that Applicants would provide remarks regarding MPEP 2106.01 regarding Claim 74 as amended defining statutory subject matter.

In reply to the outstanding Office Action, Applicants appreciatively acknowledge the identification of allowable subject matter. In particular, Claim 99 has been amended to be in independent form, including the subject matter of now canceled Claim 98. Likewise,

dependent Claims 105-108 have been amended, to depend from Claim 99, and are therefore also believed to be in allowable form. In particular, Claims 105-108 have been amended to depend from Claim 99, a method claim. Claims 91, 97-98 and 100-103 have been canceled without prejudice or disclaimer, and therefore the rejections with regard to these claims is now believed to be moot.

Claim 74 has been amended, as discussed above, to define a non-transitory recording medium, which is consistent with present USPTO practice regarding claimed statutory subject matter for recording media¹. No new matter is added.

Regarding the scope of Claim 74, Claim 74 has been amended to further require that the first audio signal (after being compressed and encrypted) is embedded as noise in the second digital audio signal. This amendment has been made consistent with the amendment previously made to Claim 1, where the first audio signal is described as being compressed and encrypted before being embedded.

The outstanding Office Action indicates that based on the Office's construction of Claim 74 as being directed to non-functional descriptive material, the content of the printed matter will not distinguish the claimed product from the prior art. In this way, the Office Action concludes that Tanaka anticipates Claim 74 since not all of the language of Claim 74 has been given patentable weight.

In view of the amendment to Claim 74 being identified as a non-transitory recording medium, and also having a structure in which the first digital audio signal occurs as noise in the combination after the first audio signal was compressed and encrypted, is believed Claim 74 defines a structural relationship between the information contained on the recording medium, and the machine that performs the functions. Moreover, M.P.E.P. § 2106.01 indicates that a claimed computer-readable medium encoded with a data structure that defines

¹ Kappos, Notice regarding "Subject Matter Eligibility of Computer Readable Media", Jan. 26, 2010.

structural and functional interrelationships between the data structure and the computer software and hardware components that permits the data structures functionality is statutory. The first audio signal, in Claim 74, is compressed and encrypted and embedded as “noise” in the digital audio signal. This “noise”, relates to computer software and hardware components because it is computer software and hardware components that read the data and perceive the first signal as being “noise”. Therefore, there is a particular relationship between the information recorded in the recording medium, and the hardware and software, which perceive the first digital signal, as “noise”, and not particular data. As such it is respectfully requested that Claim 74, as amended, be construed, considering all of the subject matter defined in Claim 74, including the combination of the first digital audio signal that is embedded as noise in the second digital audio signal, as claimed. Thus, for substantially the same reasons as discussed above that Claim 1, it is believed that Claim 74 patentably defines over Tanaka. Therefore, it is respectfully submitted that Claims 74 and dependent Claims 75-85, as amended, also patentably define over the asserted prior art.

Consequently, in view of the allowable subject matter identified in the Office Action, and the amendment to Claims 74 and 99, that Claims 1, 2, 5-90, 92-96, 99, and 104-108, as

amended, is statutory and patentably distinguishing over the asserted prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)